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EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,447

Applicant(s)

HUANG, YADONG

Examiner

Ann Y. Lam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003 and 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 11 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/03, 12/03, 5/06, 7/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

As a preliminary matter, the sequence compliance requirement set forth in April 10, 2006, is hereby withdrawn.

Drawings

The drawings are objected to because the figure must not be enumerated since there is only one figure (see Rule 1.84 (u)(i)).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: the brief description of the drawings should not refer to an enumerated figure since there is only one figure (see the above requirement regarding the drawing).

Appropriate correction is required.

Claim Objections

Claim 11 is objected to because of the following informalities: the second "apoE" should be deleted as being redundant. Appropriate correction is required.

Claim 18 is objected to because of the following informalities: the second period at the end of the sentence should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in the preamble a method for diagnosing Alzheimer's disease. However the body of the claim does not recite a step of diagnosing, nor how the diagnosis is made. For example, it is not clear whether the mere presence of the

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carboxyl-terminal truncated apoE indicative of Alzheimer's disease, or whether an increased level of carboxyl-terminal truncated apoE is indicative of Alzheimer's disease.

Claim 5 recites "the carboxyl-terminal truncated apoE comprises amino acids 244-260 of apoE". It is not clear as to what positions Applicant is referring because Applicant does not indicate from where the positions are determined. For example, Applicant has not indicated that the positions are determined starting from the amino terminal end or whether it is determined starting from the other end.

The remainder of the claims are vague and indefinite because they depend from claim 1 which is vague and indefinite for the reason set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses et al., 5,508,167, in view of Huang et al., "Apolipoprotein E fragments present in Alzheimer's disease brains induce neurofibrillary tangle-like intracellular inclusions in neurons", Proc. Natl. Acad. Sci. USA, 98:8838-8843, (2001).

Roses et al. disclose the invention substantially as claimed. More specifically, as to claim 1, Roses et al. disclose a method for diagnosing Alzheimer's disease

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comprising detecting apoE4 in a biological sample (col. 2, lines 18-26; and col. 3, lines 55-58). Roses et al. teach that the presence of an apoe4 indicates that the subject is afflicted with Alzheimer's disease (col. 2, lines 23-25).

However, Roses et al. teach detecting apoE4 rather than carboxyl-terminal truncated apoE, as recited by Applicant. However, Huang et al. teach that carboxyl-terminal-truncated forms of apoE is found to be higher in patients with Alzheimer's disease than in normal patients (i.e., patients without Alzheimer's disease), (see abstract, and see page 8839, right column.) While Huang et al. do not specifically disclose that the presence of the carboxyl-terminal-truncated apoE can be used to diagnose Alzheimer's disease, nevertheless, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Roses et al. method to diagnose a patient to have Alzheimer's disease by detecting that carboxyl-terminal-truncated apoE level in the patient is higher than in a patient that does not have Alzheimer's disease because Huang et al. teach the correlation between the presence of a higher level of carboxyl-terminal-truncated apoE and the presence of Alzheimer's disease.). In other words, in view of the teachings of Roses et al. that the presence of an apoe4 indicates that the subject is afflicted with Alzheimer's disease (col. 2, lines 23-25), and that thus, a method for diagnosing Alzheimer's disease would comprise detecting apoE4 in a biological sample (col. 2, lines 18-26; and col. 3, lines 55-58), it would have been obvious to one of ordinary skill in the art to diagnose Alzheimer's disease by detecting carboxyl-terminal-truncated apoE because Huang et al. teach that

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the presence of carboxyl-terminal-truncated apoE level is found to be higher in patient's with Alzheimer's disease than in patients without the disease.

As to claims 2 and 3, neither Roses et al. nor Huang et al. teach that the carboxyl-terminal truncated apoE is in a blood or serum sample. However, Roses et al. teach that the apoE is detected in a blood sample (col. 2, lines 28-34). Roses et al. teach that any sample of biological material containing apoE may be used, such as blood or serum or any other fluid or tissue containing apoE from the subject (col. 9, line 66 – col. 10, line 2). Roses et al. give an example of using serum in column 11, lines 19-45.)

Because Roses et al. teach that apoE is found in blood and serum, it would have been obvious to one of ordinary skill in the art at the time the invention was made to assay for carboxyl-terminal truncated apoE in a sample that is blood or serum. In other words, because Roses et al. teach that apoE is found in blood and serum and is an indication of Alzheimer's disease, and Huang et al. teach the presence of carboxyl-terminal truncated apoE in patients with Alzheimer's disease, it would have been obvious to test for the carboxyl-terminal truncated apoE in a sample that is blood or serum as Roses et al. teach that apoE is found in blood and serum and is not localized outside of blood or serum.

As to claim 4, the carboxyl-terminal truncated apoE has a molecular weight of about 14-20 kDa (page 8839, right column, second full paragraph).

As to claim 5, because it is not clear as to what fragment is being referred in claim 5 (see the 112, second paragraph rejection above), the carboxyl-terminal

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truncated apoE disclosed by Huang et al. (fragment with the molecular weight of about 14-20 kDa on page 8839, right column, second full paragraph) is deemed to be the carboxyl-terminal truncated apoE comprising amino acids 244-260 of apoE.

As to claim 6, apoE is apoE4 (see page 8840, right column; and page 8842, right column, first full paragraph; and page 8843, right column). (Huang et al. teach on page 8843, right column, that the study demonstrates that carboxyl-terminal truncated fragments of apoE induce NFT-like inclusions in neuronal cells and that both quantitative and qualitative differences in the abilities of apoE4 and apoE3 to induce these inclusions could contribute to the increased susceptibility of human apoE4 carriers to Alzheimer's disease. Huang et al. teach on page 8842, right column, first full paragraph, that carboxyl-terminal truncated forms of apoE3 and apoE4 induce NFT-like inclusions in neuronal cells. Thus Huang et al. make a correlation between carboxyl-terminal truncated apoE4 and Alzheimer's disease.)

As to claim 7, apoE is apoE3 (see page 8840, right column; and page 8842, first full paragraph; and page 8843, right column). (Huang et al. teach on page 8843, right column, that the study demonstrates that carboxyl-terminal truncated fragments of apoE induce NFT-like inclusions in neuronal cells and that both quantitative and qualitative differences in the abilities of apoE4 and apoE3 to induce these inclusions could contribute to the increased susceptibility of human apoE4 carriers to Alzheimer's disease. Huang et al. teach on page 8842, right column, first full paragraph, that carboxyl-terminal truncated forms of apoE3 and apoE4 induce NFT-like inclusions in

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neuronal cells. Thus Huang et al. make a correlation between carboxyl-terminal truncated apoE3 and Alzheimer's disease.)

As to claim 8, neither Roses et al. nor Huang et al. teach that the apoE is a mixture of apoE3 and apoE4. However Huang et al. teach on page 8843, right column, that the study demonstrates that carboxyl-terminal truncated fragments of apoE induce NFT-like inclusions in neuronal cells and that both quantitative and qualitative differences in the abilities of apoE4 and apoE3 to induce these inclusions could contribute to the increased susceptibility of human apoE4 carriers to Alzheimer's disease. Huang et al. teach on page 8842, right column, first full paragraph, that carboxyl-terminal truncated forms of apoE3 and apoE4 induce NFT-like inclusions in neuronal cells. Thus Huang et al. make a correlation between both carboxyl-terminal truncated apoE3 and apoE4 and Alzheimer's disease. It would have been obvious to one of ordinary skill in the art at the time the invention was made to assay for both, i.e., a mixture of, the carboxyl-terminal truncated apoE3 and carboxyl-terminal truncated apoE4 because Huang et al. make a correlation between Alzheimer's disease and the presence of both carboxyl-terminal truncated apoE3 and carboxyl-terminal truncated apoE4. The Office notes that Applicant's recitation of apoE encompasses carboxyl-terminal truncated apoE (and more specifically carboxyl-terminal truncated apoE3 and carboxyl-terminal truncated apoE4).

As to claim 9, the detecting step is detecting a level of carboxyl-terminal truncated apoE in the bodily fluid (see above regarding claim 2—blood or serum is bodily fluid).

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As to claim 10, neither Roses et al. nor Huang et al. teach that the method further comprises detecting a level of full length apoE in the biological sample from the individual; wherein a ratio of the level of carboxyl-terminal truncated apoE compared to the level of full length apoE in the biological sample that is greater than a ratio associated with a control biological sample from an individual not having Alzheimer's disease is indicative of a diagnosis of Alzheimer's disease. However, Huang et al. teach that full length apoE were found in normal subjects as well as Alzheimer's disease patients but that the carboxyl-terminal truncated forms of apoE fragments occurred to a greater extent in Alzheimer's disease patients (page 8839, right column). Thus, the data disclosed by Huang et al. show that the ratio of carboxyl-terminal truncated apoE fragments to full length apoE occur higher in Alzheimer's disease patients, because carboxyl-terminal truncated forms occur to a greater extent in Alzheimer's disease patients than in normal subjects while the full length apoE were found in both normal subjects as well as Alzheimer's disease patients. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the ratio of the level of carboxyl-terminal truncated apoE compared to the level of full length apoE in the biological sample that is greater than a ratio associated with a control biological sample from an individual not having Alzheimer's disease is indicative of a diagnosis of Alzheimer's disease because the data disclosed by Huang et al. disclose the correlation.

As to claim 11, the carboxyl-terminal truncated apoE has a molecular weight of about 14-20 kDa (page 8839, right column, second full paragraph).

As to claims 12, 13 and 14, neither Roses et al. nor Huang et al. teach that the ratio is greater than about 1.5 (as recited in claim 12), nor about 2 (as recited in claim 13), nor about 3 (as recite in claim 14). However, as discussed above regarding claim 10, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the ratio of the level of carboxyl-terminal truncated apoE compared to the level of full length apoE in the biological sample that is greater than a ratio associated with a control biological sample from an individual not having Alzheimer's disease is indicative of a diagnosis of Alzheimer's disease because the data disclosed by Huang et al. disclose the correlation. While Huang et al. do not disclose the ratio being 1.5 or 2 or 3, however, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, Roses et al. in view of Huang et al. disclose the general conditions of the claim (see above regarding claims 1 and 10), and thus discovering that the ratio of 1.5 or 2 being indicative of Alzheimer's disease requires only routine skill in the art under *In re Aller*.

As to claim 15, Roses et al. teach a kit comprising an antibody and instructions for using the antibody for diagnosing Alzheimer's Disease (col. 9, lines 11-16; and col. 11, lines 5-10). With the modification of the Roses et al. invention in view of Huang et al, the antibody is the antibody that binds to carboxyl-truncated apoE as disclosed by Huang et al. (see page 8839, right column, second full paragraph, and also brief description of fig. 1)

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As to claim 16, the antibody is attached to a solid support (col. 2, lines 45-46 and col. 11, lines 5-10).

As to claim 17, the kit further comprises an antibody that specifically binds to a carboxyl-terminal portion of apoE. (With the modification of the Roses et al. invention in view of Huang et al, the antibody is the antibody that binds to carboxyl-truncated apoE as disclosed by Huang et al.--see page 8839, right column, second full paragraph, and also brief description of fig. 1)

As to claim 18, with the modification of the Roses et al. invention (see above regarding claim 1s and 15), including the kit with instructions on detecting apoE to diagnose Alzheimer's disease, it would have been obvious that the instructions direct the use of the kit to detect carboxyl-terminal truncated apoE in serum.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Ann Lam